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PATENT
Attorney Docket No. 026595-004800US

TOWNSEND and TOWNSEND and CREW LLP

By: /BonnieRickles/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Robert Staggs

Application No.: 10/783,715

Filed: February 19, 2004

For: METHODS AND SYSTEMS FOR
PROVIDING PERSONALIZED
FREQUENTLY ASKED QUESTIONS

Confirmation No.: 5593

Examiner: Belix M. Ortiz

Art Unit: 2164

APPELLANT'S BRIEF UNDER
37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Further to the Notice of Appeal mailed on June 29, 2009 for the above-referenced application, Appellant submits this Brief on Appeal.

1. REAL PARTY IN INTEREST

The Western Union Company is the real party in interest as the assignee of the above-identified application.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. STATUS OF CLAIMS

Claims canceled: 12-17, 25

4. STATUS OF AMENDMENTS

No claim amendments have been submitted subsequent to the mailing of the Final Office Action dated April 13, 2009 (the "Office Action").

5. SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1, 18, 24 and 29 are the independent claims. In the following summary, Appellant provides references to sections of the Specification and Drawings supporting the subject matter defined in the claims as required by 37 C.F.R. §41.37. These references are intended to be illustrative in nature only.

The claimed subject matter relates to methods and systems for providing personalized frequently asked questions (FAQs).

Independent claim 1 sets forth a computer-implemented method for providing personalized frequently asked questions (FAQs) to a user, including receiving a request from a user to access a frequently asked questions (FAQ) page having at least one question with an corresponding answer (step 202, Fig. 2), retrieving account data (associated with personal data) for the user (step 204), selecting at least one of a set of questions to display to the user based on the account data (step 206), and displaying the selected questions along with the corresponding

answers (step 212) so that the set of questions are personal to the user based on the personal data of the user, rather than based solely on topics selected by the user (Specification, p. 3, lines 20-29; p. 4, line 23 through p. 5, line 14).

Independent claim 18 sets forth a computer-implemented method for providing personalized frequently asked questions (FAQs) to a user, including receiving a request from a user to access a frequently asked questions (FAQ) page having at least one question with an corresponding answer about a loan acceleration program (step 202, Fig. 2; Specification, p. 5, lines 23-31), retrieving account data for the user that includes a type of repayment schedule for the loan acceleration program (step 204), selecting a first question to display to the user based on type of repayment schedule (step 206; Specification, p. 6, lines 2-3), using the account data to select at least one additional question to display to the user and displaying the selected questions along with the corresponding answers to the user (Specification, p. 3, lines 20-29; p. 4, line 23 through page 5, line 14; p. 6, lines 3-8).

Independent claim 24 sets forth a system for providing a frequently asked questions (FAQ) page having at least one question with an corresponding answer, including a first set of data containing a plurality of questions (questions 100, Fig.1), a second set of data containing account data associated with personal data for a plurality of users (user account data 120), a third set of data containing a plurality of answers (answers 110), and logic (logic 130) for receiving a request from a user to access the frequently asked questions (FAQ) page, for retrieving account data for the user from the second set of data, and for selecting a group of questions from the first set of data and answers from the third set of data to display to the user based on the account data, so that the displayed group of questions are personal to the user (Specification, p. 4, lines 1-12).

Independent claim 29 sets forth a computer-implemented method for providing personalized frequently asked questions (FAQs) to a user, including receiving a request from a user to access a frequently asked questions (FAQ) page having at least one question with an corresponding answer (step 202, Fig. 2), retrieving account data (associated with personal data) for the user (step 204), selecting a set of questions to display to the user based on the account data (step 206), determining an order for the set of questions based on the account data (step 210;

Specification, p. 5, lines 8-14), and displaying the selected questions along with the corresponding answers in the determined order (step 212; Specification, p. 5, lines 11-12).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Ground of Rejection I: Claims 1-7 and 29-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,842,221 to Schmonsees (“**Schmonsees**”) in view of U.S. Patent Application Publication No. 2004/0133474 to Tami (“**Tami**”).

B. Ground of Rejection II: Claims 18, 20, 22-24 and 26-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Schmonsees** in view of U.S. Patent No. 6,377,944 to Busey (“**Busey**”) and further in view of **Tami**.

C. Ground of Rejection III: Claims 8-11 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable to **Schmonsess** in view of **Tami**, and further in view of U.S. Patent Application Publication No. 2003/0018629 to Namba (“**Namba**”).

D. Ground of Rejection IV: Claim 21 stands rejected under 35 U.S.C. 103(a) as being unpatentable to **Schmonsees** in view of **Busey** and in view of **Tami**, and further in view of US. Patent Publication Application No. 2003/020018 to **Lee**.

7. ARGUMENT

Ground of Rejection I

The Examiner rejected independent claims 1 and 29, and dependent claims 2-7 and 30 under 35 U.S.C. 103(a) as being unpatentable over **Schmonsees** in view of **Tami**.

Independent Claim 1

As to independent claim 1, the Examiner states (page 3 of the Office Action) that **Tami** teaches the following claim features not taught in **Schmonsees**:

“selecting at least one of a set of questions to display to the user based on the account data so that the set of questions are personal to the user based on the personal data of the user, rather than based solely on topics selected by the user (see paragraphs 442-443 [of **Tami**]); and

wherein the selected questions along with the corresponding answers are displayed to the user (see paragraphs 416, 424 and 443 [of **Tami**]).”

In **Tami**, a customer is provided with a data card having a customer ID code, so that transaction data may be collected at a retail POS terminal and personalized interactive responses may be geared to the customer and stored in a customer response database 506 (Abstract; paragraph 0416). During the customer's next visit, the personalized responses (e.g., personalized promotions, surveys or incentives) are displayed to the customer at a POS terminal and are intended to encourage the customer to return to make further purchases (paragraph 0420). Each time the customer visits the retailer, further promotional responses are provided and the collected data is used to further tailor the responses for future visits (paragraphs 0424, 0442 and 0443). One example of an interactive promotional response is a promotion of dog food specials displayed at a retailer POS terminal to purchasers that are identified as dog owners in the customer response database (paragraph 0424).

Appellant respectfully submits that (1) **Tami** does not teach the features relied upon by the Examiner, and (2) that the Examiner has not offered a proper basis for combining **Schmonsees** with **Tami**.

Tami does not involve FAQs being displayed in response to a user requesting a “frequently asked questions (FAQ) page in order to obtain information.” As noted above, in **Tami** personalized interactive responses are provided to a customer for purposes of collecting data and to encourage the customer to make further purchases. In particular, and contrary to the Examiner's assertion at page 3 in the Office Action, **Tami** does not disclose selecting “questions based on account data” and then displaying “selected questions *along with the corresponding answers*” to the user as recited in claim 1. As such, even if combined, **Schmonsees** and **Tami** do not teach all the features of claim 1.

Further, Appellant respectfully submits that given the entirely different purpose of **Schmonsees** and **Tami**, that those references are not properly combined and no proper basis has been articulated for combining them.

Schmonsees, as it pertains to the present invention, discloses a conventional computerized FAQ page where a user may obtain FAQs (questions and corresponding answers)

by making a selection of a topic (Abstract; col. 5, lines 12-17). There is no suggestion nor any reason in **Schmonsees** for personalizing the FAQs based on personal data of the user. **Tami** is not concerned with FAQs. Rather, the system tracks purchases and also requests information from the user in order to provide interactive personalized responses designed to get the user to make further purchases. The user is not requesting information (as is the case in the present invention), but rather the opposite occurs (the system tracks purchasing information and solicits information *from* the user). Appellant respectfully submits that combining **Tami** with **Schmonsees** to arrive at Appellant's novel invention for providing personalized FAQs would not be obvious, and that the present invention would in fact be non-obvious since it involves "more than the predictable use of prior art elements according to their established functions. *KSR Int'l v. Teflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007).

As also stated in *KSR*, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated underpinnings to support the legal conclusion of obviousness." *Id.*, at 1396. Such a requirement has been recently affirmed by the Federal Circuit, with the Examiner required to provide "some articulated reasoning with some *rational* underpinning to support the legal conclusion of obviousness" (emphasis added). *Innogenetics N.V. v. Abbott Laboratories*, USPQ2d1641, 1648 (Fed. Cir. 2008). Appellant respectfully submits that the Examiner has not met this requirement with a general and ambiguous statement that it would be obvious to modify **Schmonsees** with **Tami** because it would "enable the method to show to the right user the account that belong[s] to that user and the method facilitate[s] the search to the user providing information in view of the user personal data" (pages 3 and 4 of the Office Action). As best understood, this rationale appears to mean that that one would be motivated to show to a user the proper account that belongs to that user (rather than accounts belonging to other users) and that a search by a user would provide information based on personal data of that user. Regardless of whether such a rationale is true, the rationale is not sufficient to support a combination of **Schmonsees** and **Tami**, since it is ambiguous as applied to the references and fails to provide any rational basis for understanding why one skilled in art would combine **Schmonsees** (which deals with a conventional, topic-based FAQ system) and **Tami** (which deals with a system for requesting and tracking information from

a purchaser and using that data to personalize displays to encourage the purchaser to make additional purchases).

Independent Claim 29

Independent claim 29 recites the same features as claim 1, and is allowable over **Schmonsees** and **Tami** for the same reasons as stated above. As an additional and separate argument for reversing the Examiner, Appellant points out that claim 29 also recites further features relating to the FAQs being ordered based on account data, namely:

“determining an order for the set of questions based on the account data;
and

displaying the selected questions to the user in the determined order along
with the corresponding answer.”

The Examiner states (page 5 of the Office Action) that **Schmonsees** teaches this feature (determining an order for the FAQs), citing col. 4, lines 35-43 and col. 5, lines 8-15. The cited lines simply refer to a list of questions (and subsequently the answers) being retrieved and displayed based on the selection of a topic. There is no ordering of the selected questions, and clearly no determining an order “based on account data” as recited in claim 29. Thus claim 29 is allowable over **Schmonsees** and **Tami** for this additional reason.

Dependent Claims 2-7 and 30

Dependent claims 2-7 and 30 all recite limitation in addition to their respective parent claims are believed allowable for at least the same reasons as stated above in connection with claims 1 and 29. As examples, claim 6 recites the feature referred to above in connection with claim 29 (the determining of an order for the FAQs based on the user data). Claim 30 recites that the account data used for selecting questions and determining an order is “related to activity in a user account.” Such features (as combined with the limitations of their respective parent claims) are clearly not disclosed or suggested in **Schmonsees** or **Tami**, either individually or as combined.

Ground of Rejection II

The Examiner rejected independent claims 18 and 24, and dependent claims 20, 22, 23 and 26-28 under 35 U.S.C. 103(a) as being unpatentable over **Schmonsees** in view of **Busey** and **Tami**.

Independent Claim 18

As to independent claim 18, the Examiner states (page 7 of the Office Action) that **Schmonsees** teaches (among other things):

“retrieving account data for the user, the account data including a type of repayment schedule for the loan acceleration program,” and

selecting a first question to display to the user based on type of repayment schedule,”

citing column 3, lines 50-55, column 5, lines 8-19, and claim 1 of **Schmonsees**. Appellant respectfully submits that the limitations referenced above are not disclosed in **Schmonsees** (or **Busey** and **Tami**), and thus claim 18 is allowable over such references.

Appellant has carefully reviewed these cited portions of **Schmonsees**, as well as the entire disclosure of **Schmonsees**, and finds no teaching of a repayment schedule or a loan accelerator program, and finds no teaching of selecting questions (and corresponding answers) “based on a repayment schedule” and selecting an additional question (and corresponding answer) by “using account data,” as all recited in claim 18.

In addition, the Examiner states (page 7 of the Office Action) that **Busey**, teaches “selecting at least one additional question to display to the user, using the account data,” citing Fig. 3, item 310. However, the cited element 310 in **Busey** (described at column 10, lines 12-17), is a step at a FAQ system where follow-up or additional information may be provided *based on an initial question asked by a user*. The additional information is not selected “using the account data,” as recited in claim 18.

For a rejection to be maintained under 35 U.S.C. §103(a), the Examiner is charged with factually supporting a *prima facie* case of obviousness. **MPEP 2142**. Such a *prima facie* case requires, *inter alia*, that **all limitations** of the claims be taught or suggested by the cited references and that there be some suggestion or motivation to combine and/or modify

the reference teachings as the Examiner proposes. **MPEP 2143**. Here, the Examiner has not cited references that teach or suggest this last mentioned limitation in claim 18.

Appellant also respectfully submits, as an additional argument for reversing the Examiner, that even if **Schmonsees** and **Busey** were somehow deemed to individually disclose the referenced features, the rationale used by the Examiner for combining such references (page 8 of the Office Action), namely, that it “would enable the method to show to the right user the account that belong[s] to that user and the method facilitate[s] the search to the user providing information in view of the user preferences,” is ambiguous at best and not proper under *KSR Int'l v. Teflex Inc.*, for the same reasons as mentioned above in connection with claim 1.

Independent Claim 24

As to independent claim 24, the Examiner states (page 9 and 10 of the Office Action) that **Schmonsees** teaches (among other things) logic “to select a group of questions from the first set of data and associated answers from the third set of data to display to the user based on the account data for the user, so that the displayed group of questions are personal to the user based on the personal data of the user.”

As explained earlier in connection with claim 1, **Schmonsees** discloses the selection of FAQs based on topics, and thus there is no teaching of selecting FAQs “based on account data for the user” as recited in claim 24. The Examiner also states (page 10 of the Office Action) that **Busey** teaches “a second set of data containing account data for a plurality of users (see col. 13, lines 52-56).” The Examiner's remarks are unclear (and do not match the cited lines of **Busey**), and Appellant wonders if the Examiner meant to cite **Busey** for its disclosure of inserting personalized information (e.g., an account balance) in an answer to a FAQ (see column 13, lines 56-65 of **Busey**). If that were the intention of the Examiner, Appellant points out that while **Busey** shows creation of customized FAQs using account balance data, such data is used to create answers to FAQs, and is not used to “select a group of questions from the first set of data and associated answers from the third set of data,” as recited in claim 24. Since **Schmonsees** and **Busey (and Tami)** individually or as combined do not teach or suggest the above referenced features of claim 24, claim 24 is allowable over such references.

Appellant also respectfully submits, as an additional argument for reversing the Examiner, that even if **Schmonsees**, **Busey** and **Tami** were somehow deemed to individually disclose the referenced features of claim 24, the rationale used by the Examiner for combining such references (page 10 of the Office Action), namely, that it “would enable the method to show to the right user the account that belong[s] to that user and the method facilitate[s] the search to the user providing information in view of the user preferences,” is ambiguous at best and is thus not proper under *KSR Int'l v. Teflex Inc.*, for the same reasons as mentioned above in connection with claim 1.

Dependent Claims 20, 22, 23 and 26-28

Dependent claims 20, 22, 23 and 26-28 all recite limitation in addition to their respective parent claims are believed allowable for at least the same reasons as stated above in connection with claims 18 and 24.

Ground of Rejection III

The Examiner rejected dependent claims 8-11 and 19 under 35 U.S.C. 103(a) as being unpatentable over **Schmonsees** in view of **Tami** and **Namba**.

Appellant respectfully submits that since such claims recite limitations in addition to those incorporated from their respective parent claims 1 and 18, they are allowable for at least the same reasons as stated above in connection with claims 1 and 18.

As an additional argument for reversing the Examiner, Appellant also points out that the Examiner summarily rejected various ones of these claims based on **Schmonsees** and **Namba** without a proper basis. For example, as to claims 9, 10 and 11, the Examiner merely states (page 12 of the Office Action) that **Schmonsees** and **Namba** teach that “FAQ pages have condition.” Claim 9 specifically recites that the condition is a repayment schedule that is a biweekly repayment schedule. Claims 10 and 11 recite other specific conditions. Such conditions are not disclosed in any of the references, including **Schmonsees** and **Namba**, and thus there is no proper basis given by the Examiner for finding such specific conditions obvious in view of the teaching of **Schmonsees** and **Namba**.

Ground of Rejection IV

The Examiner rejected dependent claim 21 under 35 U.S.C. 103(a) as being unpatentable over **Schmonsees** in view of **Busey, Tami and Lee**.

Appellant respectfully submits that since claim 21 recites limitations in addition to those incorporated from its parent claim 18, it is allowable for at least the same reasons as stated above in connection with claim 18.

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,

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9. CLAIMS APPENDIX

1. (Previously presented) A computer-implemented method comprising:
receiving a request from a user to access a frequently asked questions (FAQ) page
in order to obtain information, wherein the FAQ page provides at least one question with an
answer corresponding to the question;
retrieving account data for the user, wherein the account data is associated with
personal data related to the user; and
selecting at least one of a set of questions to display to the user based on the
account data so that the set of questions are personal to the user based on the personal data of the
user, rather than based solely on topics selected by the user;
wherein the selected questions along with the corresponding answers are
displayed to the user.
2. (Original) The method of claim 1, further comprising formatting a set of
personalized answers to the set of questions using the account data.
3. (Original) The method of claim 2, wherein formatting a set of
personalized answers comprises selecting a first answer for a first question from a set of answers
for the first question.
4. (Previously presented) The method of claim 2, wherein selecting a first
answer comprises determining when a condition for the first answer is satisfied.
5. (Original) The method of claim 2, further comprising displaying the set of
questions and the set of personalized answers to the user.
6. (Original) The method of claim 2, further comprising:
before displaying the questions, determining an order for the set of questions
using the user data; and
wherein displaying the set of questions comprises displaying the set of questions
in the determined order.

7. (Original) The method of claim 2, wherein formatting a set of personalized answers comprises formatting at least one question to display information specific to the user by using the user account data.

8. (Previously Presented) The method of claim 1, wherein determining the set of questions comprises:

evaluating a condition for a first question, and
when the condition is satisfied, selecting the first question.

9. (Previously presented) The method of claim 8, wherein the FAQ page is for a loan accelerator program and wherein the condition is the user having a repayment schedule that is a biweekly repayment schedule.

10. (Previously presented) The method of claim 8, wherein the FAQ page is for a travel site and wherein the condition is the user having an upcoming trip.

11. (Previously presented) The method of claim 8, wherein the FAQ page is for a online store and wherein the condition is the user having an outstanding order.

12-17. (Canceled)

18. (Previously presented) A computer-implemented method comprising:
receiving a request from a user to access a frequently asked questions (FAQ) page about a loan acceleration program, wherein the FAQ page provides at least one question with an answer corresponding to the question;

retrieving account data for the user, the account data including a type of repayment schedule for the loan acceleration program;

selecting a first question to display to the user based on type of repayment schedule; and

selecting at least one additional question to display to the user, using the account data;

wherein the selected questions along with the corresponding answers are displayed to the user.

19. (Previously presented) The method of claim 18, further comprising: determining that the account data indicates the user is eligible for a service; and selecting an answer for one of the questions from a set of answers based on the determining.

20. (Original) The method of claim 18, further comprising formatting an answer to one of the questions using the account data.

21. (Original) The method of claim 20, wherein formatting an answer comprises inserting a payment amount paid by the user into the answer.

22. (Previously presented) The method of claim 18, further comprising determining that the account data indicates a recent change to the account; and selecting a second question related to the change to display to the user.

23. (Original) The method of claim 22, further comprising ordering the second question to be displayed before the first question and the additional question.

24. (Previously presented) A system for providing a frequently asked questions (FAQ) page wherein the FAQ page provides at least one question with an answer corresponding to the question, comprising:

a first set of data containing a plurality of questions;

a second set of data containing account data for a plurality of users, wherein the account data is associated with personal data related to the user;

a third set of data containing a plurality of answers, wherein each of the answers is associated with at least one of the questions and each of the questions is associated with one or more answers;

logic, communicatively coupled to the first set of data and the second set of data, the logic to receive a request from a user to access the frequently asked questions (FAQ) page, to retrieve from the second set of data the account data for the user, and to select a group of questions from the first set of data and associated answers from the third set of data to display to the user based on the account data for the user, so that the displayed group of questions are personal to the user based on the personal data of the user.

25. (Canceled)

26. (Original) The system of claim 25, wherein the logic selects an answer to one of the group questions, based on the account data for the user, from a plurality of answers contained in the third set associated with the group question.

27. (Original) The system of claim 25, wherein the logic formats an answer to one of the group questions by inserting data obtained from the account data for the user into the answer.

28. (Original) The system of claim 24, further comprising a display mechanism to display the group of questions.

29. (Previously presented) A computer-implemented method comprising:
receiving a request from a user to access a frequently asked questions (FAQ) page in order to obtain information, wherein the FAQ page provides at least one question with an answer corresponding to the question;

retrieving account data for the user, wherein the account data is associated with personal data related to the user; and

selecting a set of questions to display to the user based on the account data so that the set of questions are personal to the user based on the personal data of the user, rather than based solely on topics selected by the user;

determining an order for the set of questions based on the account data; and

displaying the selected questions to the user in the determined order along with the corresponding answer.

30. (Previously presented) The method of claim 1, wherein the account data is related to activity in a user account.

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10. EVIDENCE APPENDIX

NONE

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11. RELATED PROCEEDINGS APPENDIX

NONE